

**REMARKS**

**I. Amendments to the Claims**

After entry of this amendment, claims 1-6, 8-13, 14, and 16 will be pending in the application.

In order to clarify Z and the position of the carbon atom in Z, claim 1 has been amended to recite that “Z represents a group of atoms forming an alicyclic hydrocarbon group together with the carbon atom adjacent to Ra<sub>11</sub>.” This amendment is editorial in nature and is not intended to change the scope of the claims.

Claim 1 has also been amended to include the subject matter of original claim 7.

New claim 15 recites, in independent form, the subject matter of original claim 5.

New claim 16 recites the subject matter of original claim 12.

Claims 5 and 14 have been canceled.

**II. Objections to the Claims**

At page 2, paragraph 2 of the Office Action, claim 1 is objected to for the use of the term “atom group” to describe Z in the formula (Ia). The Examiner states that it is unclear if Z is a group of atoms.

In response, Applicants have amended claim 1 to recite that “Z represents a group of atoms . . .” Accordingly, Applicants respectfully request reconsideration and withdrawal of this objection.

### **III. Claim Rejections Under 35 USC § 103 - Obviousness**

At page 2, paragraph 4 of the Office Action, claims 1-4, 6, 8-11, and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ushirogouchi et al. (US 6,440 636 B1) in view of Kodama (US 6 733 951 B2).

According to the Examiner, the difference between Ushirogouchi et al. and the present invention is the specific use of photo acid generators based on sulfonium compounds containing conjugated unsaturation or benzoyl groups. To remedy this deficiency, the Examiner relies on Kodama, indicating that given Ushirogouchi et al.'s disclosure of photoresist compositions comprising resins with good alkali solubility (citing column 2, lines 1-6), it would have been obvious to one of ordinary skill in the art at the time the invention was made to include acid generators taught by Kodama in the resist compositions of Ushirogouchi et al., thereby obtaining the instant invention.

Applicants submit that there is a clear difference between the present claims and the cited documents, because the present claims recite the combination of the specific polymer (A) and the specific compound (B).

Nevertheless, in order to further prosecution of the present application, Applicants have amended independent claim 1 to recite the subject matter of original claim 7. As a result of this amendment, claim 8 now recites the subject matter of original claim 14. In addition, as noted above, new claims 15 and 16 recite the subject matter of original claims 5 and 12. Because the Examiner has indicated that claims 5, 7, 12, and 14 recite patentable subject matter (see page 4,

paragraph 5 of the Office Action), such amendments should place the present application in condition for allowance.

Thus, Applicants respectfully request reconsideration and withdrawal of the obviousness rejection.

#### IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Lisa E. Stahl  
Registration No. 56,704

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE  
**23373**  
CUSTOMER NUMBER

Date: October 13, 2005